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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,757	10/01/2001	John S. Hendricks	007412.00281	7416
71/867 7590 02/14/2011 BANNER & WITCOFF, LTD ATTORNEYS FOR CLIENT NUMBER 007412 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
2424				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/966,757

**Applicant(s)**

HENDRICKS, JOHN S.

**Examiner**

JAMES SHELEHEDA

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-16, 18-20, 22, 24, 26-28, 30-32, 34-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-16, 18-20, 22, 24, 26-28, 30-32, 34-36 and 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-943)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6, 8-16, 18-20, 22, 24, 26-28, 30-32, 34-36 and 38-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1, lines 3-4, recites "a tuner configured to receive a video channel including a split screen with multiple video clips positioned in different portions of the split screen" and lines 7-8 recites "wherein the single video clip is repositioned from one of the different portions of the split screen to a position in the menu".

The disclosure as originally filed fails to provide enabling support for transmitting/receiving a video channel "including a split screen with multiple video clips positioned in different portions of the split screen". While the specification indicates that

videos may be transmitted using a "split screen technique" with "different videos on different portions of the screen" (see pages 15, 30-31), the specification provides no guidance towards how to generate a split screen channel. While the specification indicates that all of the video content would be transmitted in digital compressed form (see for example, pages 18-19), there is no indication as to how a digital split screen video channel including a split screen with multiple video clips positioned in different portions of the split screen is achieved.

The disclosure as originally filed fails to provide enabling support for repositioning a single video clip from one of the different portions of a split screen to a position in the menu. While the specification indicates that "scaling and redirecting video is generally difficult, expensive and requires additional hardware" (page 31, lines 1-2) there is no disclosure of what hardware would be needed and how the scaling and redirecting is achieved. Figs. 7a-b show the video being decompressed at a video decompressor (618) and then being combined with text/graphics at a video combiner (624). There is no disclosed hardware capable of identifying one single video clip from a plurality received within a split screen, and then scaling and repositioning the one video clip. The specification is explicit in indicating that this process is difficult and requires additional unidentified hardware (page 31, lines 1-2).

Claim 8, lines 6-7, recites "a tuner configured to receive a video channel including a split screen with multiple video clips positioned in different portions of the

split screen" and lines 14-15 recites "wherein the single video clip is repositioned from one of the different portions of the split screen to a position in the menu".

The disclosure as originally filed fails to provide enabling support for transmitting/receiving a video channel "including a split screen with multiple video clips positioned in different portions of the split screen". While the specification indicates that videos may be transmitted using a "split screen technique" with "different videos on different portions of the screen" (see pages 15, 30-31), the specification provides no guidance towards how to generate a split screen channel. While the specification indicates that all of the video content would be transmitted in digital compressed form (see for example, pages 18-19), there is no indication as to how a digital split screen video channel including a split screen with multiple video clips positioned in different portions of the split screen is achieved.

The disclosure as originally filed fails to provide enabling support for repositioning a single video clip from one of the different portions of a split screen to a position in the menu. While the specification indicates that "scaling and redirecting video is generally difficult, expensive and requires additional hardware" (page 31, lines 1-2) there is no disclosure of what hardware would be needed and how the scaling and redirecting is achieved. Figs. 7a-b show the video being decompressed at a video decompressor (618) and then being combined with text/graphics at a video combiner (624). There is no disclosed hardware capable of identifying one single video clip from a plurality received within a split screen, and then scaling and repositioning the one video clip.

The specification is explicit in indicating that this process is difficult and requires additional unidentified hardware (page 31, lines 1-2).

Claim 22, lines 6-7, recites "a tuner configured to receive a video channel including a split screen with multiple video clips positioned in different portions of the split screen" and lines 17-19 recites "a single video clip of the multiple video clips is repositioned from one of the different portions of the split screen to a position in one of the menus".

The disclosure as originally filed fails to provide enabling support for transmitting/receiving a video channel "including a split screen with multiple video clips positioned in different portions of the split screen". While the specification indicates that videos may be transmitted using a "split screen technique" with "different videos on different portions of the screen" (see pages 15, 30-31), the specification provides no guidance towards how to generate a split screen channel. While the specification indicates that all of the video content would be transmitted in digital compressed form (see for example, pages 18-19), there is no indication as to how a digital split screen video channel including a split screen with multiple video clips positioned in different portions of the split screen is achieved.

The disclosure as originally filed fails to provide enabling support for repositioning a single video clip from one of the different portions of a split screen to a position in the menu. While the specification indicates that "scaling and redirecting video is generally difficult, expensive and requires additional hardware" (page 31, lines 1-2) there is no

disclosure of what hardware would be needed and how the scaling and redirecting is achieved. Figs. 7a-b show the video being decompressed at a video decompressor (618) and then being combined with text/graphics at a video combiner (624). There is no disclosed hardware capable of identifying one single video clip from a plurality received within a split screen, and then scaling and repositioning the one video clip. The specification is explicit in indicating that this process is difficult and requires additional unidentified hardware (page 31, lines 1-2).

Claim 24, lines 2-3, recites " receiving a video channel including a split screen with multiple video clips positioned in different portions of the split screen" and lines 4-6 recites "a single video clip of the multiple video clips repositioned from one of the different portions of the split screen to a position in the electronic program guide".

The disclosure as originally filed fails to provide enabling support for transmitting/receiving a video channel "including a split screen with multiple video clips positioned in different portions of the split screen". While the specification indicates that videos may be transmitted using a "split screen technique" with "different videos on different portions of the screen" (see pages 15, 30-31), the specification provides no guidance towards how to generate a split screen channel. While the specification indicates that all of the video content would be transmitted in digital compressed form (see for example, pages 18-19), there is no indication as to how a digital split screen video channel including a split screen with multiple video clips positioned in different portions of the split screen is achieved.

The disclosure as originally filed fails to provide enabling support for repositioning a single video clip from one of the different portions of a split screen to a position in the menu. While the specification indicates that "scaling and redirecting video is generally difficult, expensive and requires additional hardware" (page 31, lines 1-2) there is no disclosure of what hardware would be needed and how the scaling and redirecting is achieved. Figs. 7a-b show the video being decompressed at a video decompressor (618) and then being combined with text/graphics at a video combiner (624). There is no disclosed hardware capable of identifying one single video clip from a plurality received within a split screen, and then scaling and repositioning the one video clip. The specification is explicit in indicating that this process is difficult and requires additional unidentified hardware (page 31, lines 1-2).

4. Claims 27, 31, 32, 35, 36, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 27, 31, 35 and 39 recite "display the single video clip in one of the menus by displaying the video channel with an overlay that masks one or more of the multiple video clips other than the single video clip". Claims 27, 31, 35 and 39, however, are dependent from claims 1, 8, 22 and 24, which recite that the single video clip is repositioned into the menu.



Applicant's disclosure as originally filed indicates that masking and repositioning are *alternative* methods of inserting one split screen video into the menu (pages 30, line 22-page 31, line 2). Masking is less expensive and requires no special hardware, but results in menu formatting issues (page 30, lines 22-31). Repositioning is more expensive and requires additional hardware (page 31, lines 1-2).

Applicant's disclosure as originally filed provides no specific support for system which displays the single video clip by *both* repositioning the video clip and masking one or more video clips.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/  
Primary Examiner, Art Unit 2424

JS